

REMARKS

This is a full and timely response to the Office Action of September 11, 2006. Reconsideration and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Response, claims 1, 10-11, and 31-32 are pending in this application. Claims 2-9 and 12-30 have been canceled. The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims. Applicants believe that no new matter has been added by the amendments and that a new search is not necessary.

CLAIMS

Double Patenting Rejection

Claims 1, 10-11, and 31-32 have been provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 16-35, and 1, 2, and 4-12 in Application Nos. 11/345,479 and 10/623,005, respectively.

Although Applicants traverse the rationale presented in the Office Action for all rejections, Terminal Disclaimers are filed herewith in compliance with 37 C.F.R. §1.321(c) to overcome the two provisional double patenting rejections (Appendix A and B). Accordingly, Applicants respectfully request that the double patenting rejection to pending claims 1, 10-11, and 31-32 be withdrawn.

In filing the Terminal Disclaimers, Applicants rely upon the rulings of the Federal Circuit that the filing of such a Terminal Disclaimer does not act as an admission, acquiescence, or estoppel on the merits of the obviousness issue. "In legal principal, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection." Quad

Environmental Tech v. Union Sanitary, 946 F.2d 870, 874 (Fed. Cir. 1991); and Ortho Pharmaceutical Corp. v. Smith, 959 F.2d 936, 941-942 (Fed. Cir. 1992).

Claim 1

Claim 1 is rejected under 35 U.S.C. §102(e) as purportedly being anticipated by Patel et al. (U.S. Patent Application Publication 2004/0145088 (“Patel I”)) and Patel et al. (U.S. Patent Application Publication 2004/0207123 (“Patel II”)).

Applicants traverse each of the §102 rejections in the Office Action and submit that the rejection of claim 1 under 35 U.S.C. §102 (e) in view of each Patel I and Patel II should be withdrawn because none of the references, individually or in combination, disclose, teach, or suggest each and every feature of claim 1 above. In this regard, Patel I and Patel II do not, individually or in combination, disclose, teach, or suggest “dispensing a layer of the at least one norbornene build material, wherein the norbornene based build material is dispensed from a first ink-jet printhead...dispensing a layer of the initiator onto the layer of the at least one norbornene build material thereby forming a multi-part norbornene based curable material, wherein the initiator is dispensed from a second ink-jet printhead...” as recited in claim 1.

It appears that the Office Action is suggesting that each of Patel I and Patel II teach the use of a norbornene. The Office Action appears to suggest that oxetane is equivalent to norbornene. Oxetane is a heterocyclic compound (C_3H_6O), while norbornene is a bridged cyclic hydrocarbon (C_7H_{10}). Applicants submit that oxetane and norbornene are completely different compounds. Thus, Patel I and Patel II, individually or in combination, do not disclose, teach, or suggest, at least the limitations and combinations of limitations in claim 1, and therefore, the rejection of claim 1 should be withdrawn.

If Applicants understanding of the Office Action is not accurate, Applicants respectfully request that the Examiner call the undersigned attorney to resolve this misunderstanding.

Claims 10 and 11

Applicants traverse each of the §102 rejections in the Office Action. Applicants respectfully submit that pending dependent claims 10 and 11 include every feature of independent claim 1 and that Patel I and Patel II each fail to disclose, teach, or suggest, individually or in combination, at least the features of claim 1 highlighted hereinabove. Thus, pending dependent claims 10 and 11 are also allowable over the prior art of record. In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 31

Claim 31 is rejected under 35 U.S.C. §102(e) as purportedly being anticipated by Patel et al. (U.S. Patent Application Publication 2004/0145088 (“Patel I”)) and Patel et al. (U.S. Patent Application Publication 2004/0207123 (“Patel II”)).

Applicants traverse each of the §102 rejections in the Office Action and submit that the rejection of claim 31 under 35 U.S.C. §102 (e) in view of each Patel I and Patel II should be withdrawn because none of the references, individually or in combination, disclose, teach, or suggest each and every feature of claim 31 above. The cited references do not teach “dispensing the layer of an initiator, wherein the initiator is dispensed from a first ink-jet printhead...dispensing a layer of the at least one norbornene build material onto the layer of the initiator thereby forming a multi-part norbornene based curable material, wherein the norbornene build material is dispensed from a second ink-jet printhead...curing the norbornene based curable material...,” as recited in claim 31.

It appears that the Office Action is suggesting that each of Patel I and Patel II teach the use of a norbornene. The Office Action appears to suggest that oxetane is equivalent to norbornene. Oxetane is a heterocyclic compound (C₃H₆O), while norbornene is a bridged cyclic

hydrocarbon (C_7H_{10}). Applicants submit that oxetane and norbornene are completely different compounds. Thus, Patel I and Patel II, individually or in combination, do not disclose, teach, or suggest, at least the limitations and combinations of limitations in claim 31, and therefore, the rejection of claim 31 should be withdrawn.

Claim 32

Claim 32 is rejected under 35 U.S.C. §103(a) as purportedly being unpatentable by Patel et al. (U.S. Patent Application Publication 2004/0145088 (“Patel I”)) or Patel et al. (U.S. Patent Application Publication 2004/0207123 (“Patel II”)).

Applicants traverse each of the §103 rejections in the Office Action and submit that the rejection of claim 32 under 35 U.S.C. §103 (a) in view of each Patel I and Patel II should be withdrawn because none of the references, individually or in combination, disclose, teach, or suggest each and every feature of claim 32 above. The cited references do not teach “dispensing a layer of the initiator and the at least one norbornene build material simultaneously, wherein the initiator is dispensed from a first ink-jet printhead, wherein the norbornene build material is dispensed from a second ink-jet printhead... and curing the norbornene based curable material to produce the three-dimensional object...,” as recited in claim 32.

It appears that the Office Action is suggesting that each of Patel I and Patel II teach the use of a norbornene. The Office Action appears to suggest that oxetane is equivalent to norbornene. Oxetane is a heterocyclic compound (C_3H_6O), while norbornene is a bridged cyclic hydrocarbon (C_7H_{10}). Applicants submit that oxetane and norbornene are completely different compounds. Thus, Patel I and Patel II, individually or in combination, do not disclose, teach, or suggest, at least the limitations and combinations of limitations in claim 32, and therefore, the rejection of claim 32 should be withdrawn.

Conclusion

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

In addition, any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. B. Linder', written over a horizontal line.

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CERTIFICATE OF MAILING

I hereby certify that the below listed items are being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

**Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

on 11/21/06.

Sara Rogers
Sara A. Rogers

In Re Application of:

Oliver, et al.

Serial No.: 10/642,971

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Group Art Unit: 1732

Examiner: Leo B. Tentoni

Docket No. HP: 200309784-1
TKHR: 050834-1050

For: SYSTEMS AND METHODS FOR USING NORBORNENE BASED CURABLE MATERIALS

The following is a list of documents enclosed:

Return Postcard
Amendment
Amendment Transmittal Sheet
Terminal Disclaimer (2)